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10/642,976

08/18/2003

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4389

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7590 04/30/2008  
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EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/642,976  
Filing Date: August 18, 2003  
Appellant(s): DALTON, BRIAN E.

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Floyd B. Carothers

For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 1/28/2008 appealing from the Office action mailed 9/7/2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

7008427	Sevrain	07-2006
6695846	Richelsoph et al.	02-2004
6066142	Serbousek et al.	05-2000

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2, 5-6, 8, 10-11, 14-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Beer et al. (US Patent 5,458,642). Beer et al. disclose a spinal

assembly having plates (11a and 11b) that have screw-receiving elements (the bores at the ends having screws (15a and 15b) receiving screws (Note: these are also considered screw-locking mechanisms) from respective vertebral elements, a means for permitting the distance between the elements at the ends to be shortened (springs 13c - 13g) wherein the entire device is considered as a whole to define an end and wherein the springs are capable of providing a continuous compressions as they are attached to the plates (Col. 4, lines 31-35). The device is capable of providing loading on graft material (12) disposed between the vertebral elements. The bores also function as screw head seats (see again 15a and 15b). The spring may also be considered a wire under tension, thus a compression spring.

In addition, the core/border (14) is capable of preventing the distance of the assembly from increasing. Its durable material helps the device to maintain specific shape.

Claims 1-2, 5-6, 8, 10-11, 14-15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Sevrain (US Patent 7,008,427). Sevrain discloses a plate assembly having at least two plates (Fig. 2A), with screw receiving elements (apertures for the screws (see fig. 2A) that may also be considered a screw-locking mechanism or seats, a tension spring (39) that is capable of holding the plates in a compressed position (see also Col. 5, lines 60-65). This spring is also the means by which the distance between the two portions may be shortened. The spring may also be a wire.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

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obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, 9 and 12-13, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sevrain '427 in view of Richelsoph et al. (US Patent 6,695,846). Sevrain disclose the claimed invention except for screw head seats that allow the screw to move a various 'attitudes,' considered as various orientations and a removable spacer. Richelsoph et al. disclose screw head seats (the recessed portion in the plates that allow movement of the screws, see Fig. 19), and a portion that may be considered a removable spacer (16) preventing the screw-receiving elements from being shortened at opposite ends. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Sevrain having at least screw head seats and a removable spacer in view of Richelsoph et al. to use the plate to compress the vertebrae.

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sevrain '427 in view of Serbousek et al. (US patent 6,066,142). Sevrain discloses the claimed invention except for a torque driving device to apply tension to the wire spring. Serbousek et al. disclose a torque device (134/128) that causes torque to the spring (85, and see Fig. 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Sevrain having at least a torque device in view of Serbousek et al. to better necessary torque to the assembly in

use.

### **(10) Response to Argument**

Applicant's arguments submitted 1/28/2008 have been considered but are not persuasive. Regarding the arguments with respect to Beer et al., it is noted that a spring means as claimed is required for "continuously urging...and compressive loading." Beer et al. disclose a spring. How the spring functions is considered a functional limitation wherein the spring requires only the ability to perform the functional task. The functional limitation of being "configured to" is similar to "capable of" where it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform and further does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

In this case the springs of Beer et al. are "capable of providing continuous compressive loading. Beer et al. further disclose in Col. 4, lines 65-67 that the springs may provide compression and expansion while attached to the plate. While this may be arguably be interpreted as "floating" (also cited in the Sevrain applicant arguments), it shows that the springs have the ability for a compressive function. It is well-known in the art to use springs for an application that requires some kind of tension or force. Further, it is noted that the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale to modify may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent

established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The arguments with regards to Sevrain are similar. In at least Fig. 2A, Sevrain shows a plate that is biased by a spring (39), that provides a biasing, or "compressive force" while installed to vertebrae (Col. 7, lines 63-67). Additionally, as noted previously with respect to "floating" the forces required by the spring are considered a functional limitation, requiring the ability to perform a specified function. In the previously noted citation (Col. 5, lines 60-65), the spring forces do cause a biasing force on the vertebrae.

With regards to the arguments of Sevrain in view of Richelsoph et al. it is noted that Sevrain teaches the claimed device except for specifically screw head seats for allowing various attitudes and a removable spacer. Richelsoph et al. disclose screw head seats that and removable spacers that help to keep the screws in place. In Fig. 11A and Fig 11C, for example, the screws are held in place by the spacer so they don't move. See also Col. 3, lines 60-67 through Col. 4, lines 1-15. Further, if the screws were to move in the slots, they would have moved a relative distance with respect to one another. With regards to Sevrain and Serbousek et al., Serbousek et al. teaches a device that adjusts a spring, which affects the overall tension of the device incrementally, depending on what is required for the variable position alignment guide.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/JAMES L SWIGER/

Examiner, Art Unit 3733

Conferees:

/Eduardo C. Robert/

Eduardo C. Robert

Supervisory Patent Examiner, Art Unit 3733

/Thomas Barrett/

TQAS TC3700